UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,550	01/25/2002	Richard E. Michaelson	29757/P-570	8841

4743 7590 09/12/2003

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER	
JONES, SCOTT E	

ART UNIT	PAPER NUMBER
3713	3

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/056,550	MICHAELSON, RICHARD E.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 January 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. The drawings are objected to because:

- In figure 3, box (100) is not labeled "controller" as stated on page 8, lines 3-4 of the specification.
- In figures 4A and 4B, the process flow diagram continuation lines should be labeled such that one having ordinary skill in the art would be able to follow drawings.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. Applicant's disclosure is objected to under 37 CFR 1.73 for lacking a brief summary of the invention.

(f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

5. Claims 39-41 are objected to because of the following informalities: Applicant recites "A memory having a computer program stored therein, said computer program being capable of being used in connection with a gaming apparatus, said memory comprising:" in the preamble, however, as stated, to one having ordinary skill in the art, it is unclear whether the "memory" is a computer-readable memory. Therefore the examiner suggests the following language for the preamble: "A computer-readable medium encoded with a computer program, said computer

program is used in connection with a gaming apparatus, said computer-readable medium comprising:" Correction is required.

6. It is noted that claims 21, 33, and 38 recite "the Internet". While the term "Internet" is trademarked for goods and services, it is not presently trademarked for the service of a computer network. However, it is a term that is relative given both the rate at which technology is evolving, and misuse by modern media. The Internet is an infrastructure that supports the transmission of electronic data. It consists of all servers, routers, telephone lines, satellites, and other communications instruments used to convey electronic data, including Web sites, e-mail, usenets, and newsgroups, from one point to another. By using the term Internet, Applicant must be careful to delineate whether intending to claim the infrastructure of the Internet, or use of the infrastructure. Furthermore, what is accepted as the conventional scope of the Internet today, in terms of infrastructure, is quite different from that which was accepted as briefly as five years ago, and it is unknown what will be accepted as the "Internet" of tomorrow. For these reasons, it is strongly urged that Applicant consider using more generic computer network terminology to claim the invention.

7. Claims 1, 13, 17, 31, and 39 are objected to for having improper Markush groups. In each claim, Applicant recites the following limitation, "causing a video image representing a game to be generated, said video image representing one of the following games: video poker, video blackjack, video slots, video keno, and video bingo," however, the examiner suggests the following claim language: "causing a video image representing a game to be generated, wherein said game is a game selected from the group consisting of video poker, video blackjack, video slots, video keno, and video bingo." Correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 10 and 17-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 10, the language, "comprising displaying value amounts for the game piece images of the plurality of game piece images other than the one of the game piece images after displaying the value amount" is unclear. The examiner believes applicant meant to claim something like, "comprising displaying value amounts for the game piece images of the plurality of game piece images other than the game piece selected after displaying the value amount of the game piece selected."

11. Claims 17, 22, and 34 recite the claim language, "a display unit that is capable of generating video images", however, the claim language only provides the possibility that the display unit generates video images. The limitation should be positively recited in the claim. The examiner suggests applicant amend the limitation to read, "a display unit that generates video images".

Claims 18-21, 23-33, and 35-38 inherit the deficiency of claims 17, 22, and 34, respectively, by dependency.

12. Claims 39-41 recite the claim language, "A memory having a computer program stored therein, said computer program being capable of being used in connection with a gaming apparatus, said memory comprising:", however, the claim language only provides the possibility

that the computer program is used in connection with the gaming apparatus. The limitation should be positively recited in the claim. The examiner suggests applicant amend the limitation to read, "A computer-readable medium encoded with a computer program, said computer program is used in connection with a gaming apparatus, said computer-readable medium comprising:".

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-6, 12-20, 22-24, 30-32, 34-37, and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (U.S. 6,077,163).

Walker et al. discloses a method and apparatus for operating a gaming device having a flat rate play session costing a flat rate price. The flat rate play session spans multiple plays on the gaming device over a pre-established duration. The gaming device identifies price parameters and determines the flat rate price of playing the gaming device based on those price parameters. In one embodiment, identifying price parameters includes receiving player selected price parameters. In another embodiment, price parameters further incorporate operator selected price parameters. Should the player decide to pay the flat rate price, the player simply deposits the necessary funds into the gaming device or makes a credit account available for the gaming device to debit. Once the player initiates play, the gaming device tracks the duration remaining in the flat rate play session and stops the play when the given period has elapsed, or a player

terminates the flat rate session early (by pressing a cashout button). During the play, payouts are made either directly to the player in the form of coins or indirectly in the form of credits to the player's credit account. Walker et al. additionally discloses:

Regarding Claims 1, 4, 13, 14, 17, 22, 31, 34, and 39-41:

- receiving a value amount (724) to initially define a value total (Abstract, Figs. 2B, 5, 8A-B, 11A, 15, column 2, lines 1-5, and column 3, lines 25-30);
- causing a video image representing a game to be generated, said video image representing one of the following games: video poker, video blackjack, video slots, video keno and video bingo, said video image comprising an image of at least five playing cards if said game comprises video poker, said video image comprising an image of a plurality of simulated slot machine reels if said game comprises video slots, said video image comprising an image of a plurality of playing cards if said game comprises video blackjack, said video image comprising an image of a plurality of keno numbers if said game comprises video keno, and said video image comprising an image of a bingo grid if said game comprises video bingo (Column 3, lines 1-5);
- deducting a fee at intervals from the value total independent of play of said game represented by said video image (Abstract, Figs. 2B, 5, 8A-B, 11A, 15, column 2, lines 1-5, and column 3, lines 25-30); A flat rate fee is deducted at each player session.
- determining based on the fee a value payout associated with an outcome of said game represented by said video image (Figs. 6, 8A-B, and column 6, line 56-column 12,

line 21); Based on the flat rate fee that is calculated the number of coins bet per play a pay combination jackpot is established as shown in figure 6 for example.

- adding the value payout to the value total (Fig. 13, Column 3, lines 25-30, and column 4, lines 27-35).

Regarding Claims 2, 5, 15, 18, 23, and 35:

- deducting a fixed fee periodically from the value total independent of play of said game represented by said video image (Abstract, Figs. 2B, 5, 8A-B, 11A, 15, column 2, lines 1-5, and column 3, lines 25-30); A flat rate fee is deducted at each player session.

Regarding Claims 3, 12, 16, 19, 30, and 36:

- interrupting for a period of time the deducting of a fee at intervals from the value total independent of play of said game represented by said video image (Column 4, lines 26-34). When a player cashes out early or transfers to another gaming machine the deducting of fees is interrupted.

Regarding Claims 6 and 24:

- causing a video image to be generated, the video image representing a game comprising a plurality of game piece images (cards in a Poker hand) (Column 18, lines 4-11).

Regarding Claims 20, 32, and 37:

- said gaming apparatuses being interconnected to form a network of gaming apparatuses (Fig. 1, 3, and column 3, line 40-column 4, line 4).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 7-10 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. 6,077,163) in view of Colin et al. (U.S. 6,346,043).

Walker et al. discloses to one having ordinary skill in the art that as discussed above regarding claims 1-6, 12-20, 22-24, 30-32, 34-37, and 39-41. However, Walker et al. seems to lack explicitly disclosing:

Regarding Claims 7 and 25:

- displaying a value amount when the player selects one of the game piece images from the plurality of game piece images.

Regarding Claims 8 and 26:

- determining a value payout when the player selects one of the game piece images from the plurality of game piece images.

Regarding Claims 9 and 27:

- determining a value payout prior to when the player selects one of the game piece images from the plurality of game piece images.

Regarding Claims 10 and 28:

- displaying value amounts for the game piece images of the plurality of game piece images other than the one of the game piece images after displaying the value amount.

Colin et al., like Walker et al., teaches of a card type game that is played in a gaming machine, therefore, Colin et al. and Walker et al. are analogous art. Furthermore, Colin et al. teaches of a card image matching game that allows a player to have an active role in selecting the award. After the player makes a selection, the player is then allowed to see all of the awards associated with unselected symbols that were not won. Colin et al. teaches :

Regarding Claims 7 and 25:

- displaying a value amount when the player selects one of the game piece images from the plurality of game piece images (Fig. 2 and column 3, lines 16-25).

Regarding Claims 8 and 26:

- determining a value payout when the player selects one of the game piece images from the plurality of game piece images (Figs. 8, 9 and Column 4, lines 18-24).

Regarding Claims 9 and 27:

- determining a value payout prior to when the player selects one of the game piece images from the plurality of game piece images (Box 1 of Fig. 1).

Regarding Claims 10 and 28:

- displaying value amounts for the game piece images of the plurality of game piece images other than the one of the game piece images after displaying the value amount (Column 1, lines 60-62).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Colin's game features in Walker. One would be motivated to do so because giving a player an opportunity to select an award provides a high level of satisfaction to a player. Furthermore, allowing the player to see what the award and multiplier might have been achieved if the player had made choices different than those the player made may encourage some players and make the game more fun.

17. Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. 6,077,163) in view of Colin et al. (U.S. 6,346,043) and further in view of Bennett (U.S. 6,102,798).

Walker et al. in view of Colin et al. teaches to one having ordinary skill in the art that as discussed above regarding claims 7-10 and 25-28. However, Walker et al. in view of Colin et al. seems to lack explicitly disclosing:

Regarding Claims 11 and 29:

- displaying a value amount when one of the game piece images from the plurality of game piece images is automatically selected.

Bennett, like Walker et al. and Colin et al., teaches of a game that is played on a gaming machine. Furthermore, Bennett and Colin et al. both teach of games where players select awards. Therefore, Bennett, Walker et al., and Colin et al. are analogous art. Bennett teaches:

Regarding Claims 11 and 29:

- displaying a value amount when one of the game piece images from the plurality of game piece images is automatically selected (Column 3, lines 39-45).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Bennett's automatic selection feature in Walker in view of Colin. One would be motivated to do so because this "passive" type of awarding system was notoriously well known in the art. Furthermore, automatically selecting a zone, that by definition has a prize associated with it, is highly exciting to a player.

18. Claims 21, 33, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. 6,077,163).

Walker et al. discloses to one having ordinary skill in the art that as discussed above regarding claims 1-6, 12-20, 22-24, 30-32, 34-37, and 39-41. Although Walker et al. discloses a network, Walker et al. seems to lack explicitly disclosing:

Regarding Claims 21, 33, and 38:

- said gaming apparatuses are interconnected via the Internet.

However, to one having ordinary skill in the art at the time of Applicant's invention, operating a gaming device over a network, whether the network is a LAN, WAN, or the Internet, was notoriously well known. One would be motivated to operate the gaming machines over a network such that a casino management system could monitor all monetary exchanges between the gaming machines and players.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al. ''957 and Taylor '660 disclose systems and methods for fee based wagering for a specific time period or number of slot machine pulls.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ
sej

T. Walberg
Teresa Walberg
Supervisory Patent Examiner
Group 3700